

In re Application of LUCOVSKY et al.
Serial No. 10/021,563

REMARKS

The Office action has been carefully considered. The Office action rejected claims 1-5 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,999,932 to Paul et al. ("Paul") in view of U.S. Patent No. 6,185,551 to Birrell et al. ("Birrell"). Additionally, the Office action objected to the specification for underlining and boldfacing the headings in each section, (although eliminating underlining and boldfacing is a not mandatory requirement according to the MPEP). Further, the Office action objected to the abstract because the abstract as filed contained more than 150 words. Applicants have amended the specification and the abstract to obviate the objections raised in the Office action. Regarding the rejections of the claims, applicants respectfully disagree and traverse.

By the present amendment, claims 1-3 are cancelled. Claims 6-43 have been added as new. Applicants submit that the claims as filed were patentable over the prior art of record, and that the amendments herein are for purposes of clarifying the claims and/or for expediting allowance of the claims and not for reasons related to patentability. Reconsideration is respectfully requested.

Applicants thank the Examiner for the interview held (by telephone) on January 28, 2004. During the interview, the Examiner and applicants' attorney discussed the claims with respect to the prior art. The essence of applicants' position is incorporated in the remarks below.

Prior to discussing reasons why applicants believe that the claims in this application are clearly allowable in view of the teachings of the cited and applied references, a brief description of the present invention is presented.

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The present invention is directed to a system and method for using an inbox service that allows for central (e.g., over the internet) access to specific data typically stored on a server computer. See generally FIG. 4 and pages 16-17 of the specification. The data is typically stored in the form of a content document (for example, content document 422) and the information that designates access to the data is typically stored in the form of a logical inbox document (for example, roleList document 424). These logical documents are part of a schema (for example, service schema 416) for providing the information about the structure of data stored in the system. Such a system is advantageous for storing contact information and the like such that a user may obtain a person's email address or telephone number from any device capable of connecting to the internet. Since the schema provides the information about the structure of data, any device of any platform or communication protocol may access the data.

One embodiment of the present invention features a system and method for providing a schema for coordinating the access, manipulation, and retrieval of data. The schema is a function of the class of service. In this example, the schema is directed to data structures typically used in common email platforms, *i.e.*, an inbox schema. As such, the inbox schema, which is typically in the form of a content document, includes inbox-related fields arranged having defined structures.

When another computing device wishes to access or retrieve the data, it will first be determined whether the device has permission to access or retrieve the data. As mentioned above, the inbox service includes a logical inbox document that describes a scope of access rights, *i.e.*, which users have what type of access

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to which data. For example, a data owner will have read/write access to his or her own data, and can provide various types of rights to that data to other users based on their IDs, (e.g., read only to some users, read write to others). Thus, when a user wishes to set the scope as defined in the logical inbox document, the user sends a request to manipulate the data stored in the logical inbox document which controls the scope. In response to the request, at least one set of data in a logical inbox document (data that corresponds to associated identity information) may be manipulated based on the type of request. In this way, each set of data in the logical inbox document corresponds to a related field in the inbox schema and determines the scope of access rights for users according to their identity information. Note that the above description is for example and informational purposes only, and should not be used to interpret the claims, which are discussed below.

Turning to the claims, claim 4 recites a method comprising, receiving a request to retrieve inbox data, the request including associated identity information, reading from a data store to obtain inbox data based on the associated identity information, constructing an inbox document including at least part of the data, the document arranged according to a defined schema for inbox data, and returning the document in response to the request.

The Office action rejected claim 4 as unpatentable over Paul in view of Birrell. More specifically, the Office action contends that Paul teaches constructing an inbox document including at least part of the data, the document arranged according to a defined schema for inbox data. Column 3, lines 54-67, column 4,

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lines 1-11, and column 5, lines, lines 52-59 of Paul are referenced. The Office action acknowledges that Paul does not teach the remaining recitations of claim 4, but contends that Birrell does. More specifically, the Office action contends that Birrell teaches receiving a request to retrieve inbox data, the request including associated identity information, reading from a data store to obtain inbox data based on the associated identity information. Column 5, lines 29-43, column 13, line 41 and column 16, lines 40-43 of Birrell are referenced. Further, the Office action contends that Birrell also teaches returning the document in response to the request. Column 14, lines 48-49 and column 16, lines 3-14 of Birrell are referenced. The Office action then concludes that it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified the teachings of Paul with the teachings of Birrell because adapting email to systems to organize such complex information and providing an efficient means to coherently retrieve the information is not trivial and some type of security identity information would be needed. Applicants respectfully disagree.

By law, in order to establish *prima facie* obviousness of a claimed invention, all of the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). In addition, "all words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). Further, if prior art, in any material respect teaches away from the claimed invention, the art cannot be used to support an obviousness rejection. *In re Geisler*, 116 F.3d 1465, 1471, 43 USPQ2d 1362, 1366 (Fed Cir. 1997). As discussed in greater detail below, the

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claims of the present invention are thus clearly patentable over the teachings of the cited and applied references as a matter of law.

First, Paul and Birrell, whether considered alone or in any permissible combination, do not teach each of the limitations of claim 4. Claim 4 recites constructing an inbox document including at least part of the data, the document arranged according to a defined schema for inbox data. A schema, as defined by the Microsoft Computer Dictionary, 5th Edition for example, may be a description of a database to a database management system which defines aspects of the database, such as attributes (also known as fields) and parameters of the attributes. As such, a schema may provide a "roadmap" of how fields are used in the storage of data and the schema itself may be in the form of a content document, such as XML.

The Office action contends that the term "fields" as used in Paul reads on "schema" as recited in the claims of the present invention. This interpretation of the word "fields" is not correct and cannot be supported by its use in Paul. In Paul, fields (within a typical email protocol) are monitored on each incoming email and, if the data in a field matches a filter criterion, the filter may then allow the email to pass. Paul, instead, teaches a filtering system based on fields of an email and does not disclose constructing an inbox document including at least part of the data, the document arranged according to a defined schema for inbox data as recited in claim 4.

Moreover, there is no teaching or even any appreciation of the use of a schema in the manner suggested in claim 4 in the system disclosed by Paul.

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Nowhere can there be found in Paul an inbox schema in the form of a content document such that the schema may be practiced in a common networked environment, such as the internet. Nowhere in Birrell can there be found such a document arranged according to a defined schema for inbox data. Neither Paul nor Birrell, whether considered alone or in any permissible combination, teach or even suggest a document arranged according to a defined schema for inbox data as generally recited in claim 4.

Claim 4 also recites receiving a request to retrieve inbox data, the request including associated identity information and reading from a data store to obtain inbox data based on the associated identity information. The Office action contends that Birrell teaches these recitations in column 5, lines 29-43, column 13, line 41, and column 16, lines 40-43 of Birrell. Birrell, however, fails to teach or even have any appreciation for a schema-based document access system as generally recited in claim 4. As discussed above, a schema is generally understood in the art to mean a description of a database to a database management system which defines aspects of the database. The account manager in Birrell instead is a single database for storing identity-based information and a user may, once validated by checking against the database, access the email server. The cited sections of Birrell teach, generally, a system for providing access to a mail system for remote users. More specifically, an account manager maintains information for users who are allowed to have access to the mail system. Thus, when a user wishes to access the mail system, the user must provide a user name and password that matches the identification stored in the

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account manager. Simply stated, Birrell teaches securely accessing an email server.

The system and method of the present invention is directed to a completely different concept from simply granting or denying a user access to data. The method recited in claim 4 is directed to determining the manner for which users will eventually be granted or denied permission to access various data stored in the system and the format (based on a schema) of data returned in response to a request. That is, the method of claim 4, generally speaking, provides a schema that among other things determines the setting of the scope of permissions for user access of stored data and the format of data returned in response to a request for data. The Office action fails to appreciate that the method recited in claim 4 is directed to a method for constructing an inbox document including at least part of the data, the document arranged according to a defined schema for inbox data and returning the document in response to the request, and is not directed to a security system for granting or denying access to the data itself.

For at least the reason that neither Paul nor Birrell, whether considered alone or in any permissible combination, teach all of the claim limitations recited in claim 4, applicants respectfully request that the rejection of claim 4 be withdrawn and claim 4 be allowed.

Further, by law, in order to modify a reference to reject claimed subject matter, there must be some teaching or suggestion outside of applicants' teachings to do so. Paul does not have any such teachings or suggestions as to any such modification, let alone any teaching or suggestion as to how his system could be

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modified, or why it might be desirable to do so. In specific, the motivation for Paul's system and method is to filter email messages from being received. By checking the data in various fields of an email message (*i.e.*, subject, sender, etc.) the system in Paul may prevent or allow email having matching criteria being received. Nor does Birrell have any teachings or suggestions as to any such modification of Paul. As discussed above, Birrell is directed to a system for secure access to a mail system by a remote user based on the identity information (*i.e.*, user name and password) of the user. Instead the Office action concludes that "it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Paul by the teachings of Birrell" because retrieving email "can be a security risk, especially pertaining to confidential e-mail messages, and therefore some type of security identity information would be needed." Office action page 5, line 20 – page 6 line 7. The Office action contends that the reason for combining these references is that email may be confidential and it is inherently important to protect that email with some type of security identity information. Such broad, conclusory statements do not come close to adequately addressing the issue of motivation to modify or combine, are not evidence of obviousness, and therefore are improper as a matter of law. *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). The alleged motivation was clearly based on applicants' teachings, and not on anything found in the prior art or otherwise motivated. Such wholly speculative allegations cannot reasonably be used to support these claim rejections, and applicants respectfully request withdrawal of the §103(a) rejections of the claims for at least this additional reason.

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For at least this additional reason, applicants submit that claim 4 is allowable over the prior art of record.

Applicants respectfully submit that dependent claim 5, by similar analysis, are allowable over Paul and Birrell, whether considered alone or in any permissible combination. Dependent claim 5 includes the recitations of independent claim 4. As discussed above, neither Paul nor Birrell disclose the recitations of claim 4, whether considered alone or in any permissible combination. In addition to the recitations of claim 4 noted above, dependent claim 5 includes additional patentable elements.

Applicants submit that newly added claim 6-43 are also allowable for similar reasons as discussed above with respect to claim 4. The newly added claims each contain recitations that are patentable over the prior art of record.

For example, independent claim 19 recites constructing an inbox document including at least part of the data, the document arranged according to a defined schema for inbox data. As was discussed above, there is no teaching or even any appreciation of the use of a schema in the manner suggested in claim 19 in the system disclosed by Paul. Nowhere can there be found in Paul an inbox document arranged according to a defined schema for inbox data such that the schema may be practiced in a common networked environment, such as the internet. Nowhere in Birrell can there be found such an inbox document arranged according to a defined schema for inbox data. Neither Paul nor Birrell, whether considered alone or in any permissible combination, teach or even suggest a document arranged according to a defined schema for inbox data as generally recited in claim 19.

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As another example, independent claims 21 and 35 recite returning/constructing a document arranged according to a schema associated with the service. Again, as was discussed above, there is no teaching or even any appreciation of the use of a schema in the manner suggested in claim 21 in the system disclosed by Paul. Nowhere can there be found in Paul a document arranged according to a defined schema associated with a service such that the schema may be practiced in a common networked environment, such as the internet. Nowhere in Birrell can there be found such a document arranged according to a defined schema for inbox data. Neither Paul nor Birrell, whether considered alone or in any permissible combination, teach or even suggest a document arranged according to a defined schema associated with a service as generally recited in claim 21.

As a final example, independent claim 41 recites determining a scope of access rights based on the identity information, the scope determined according to an inbox schema. Again, as shown above, neither Paul nor Birrell, whether considered alone or in any permissible combination, teach the manner of using a schema as recited in claim 41.

For at least these reasons, applicants submit that all the claims are patentable over the prior art of record. Reconsideration and withdrawal of the rejections in the Office Action is respectfully requested and early allowance of this application is earnestly solicited.

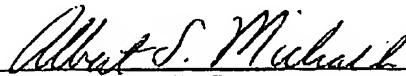
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CONCLUSION

In view of the foregoing remarks, it is respectfully submitted that claims 4-43 are patentable over the prior art of record, and that the application is good and proper form for allowance. A favorable action on the part of the Examiner is earnestly solicited.

If in the opinion of the Examiner a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney at (425) 836-3030.

Respectfully submitted,



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Date: April 1, 2004


Albert S. Michalik

3080 Amendment